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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/938,763	08/27/2001	James Norman Cawse	rd-28,250	2912
7590		03/29/2004	EXAMINER	
Philip D. Freedman		LY, CHEYNE D		
Attorney at Law		ART UNIT		
P.O. Box 19076		PAPER NUMBER		
Alexandria, VA 22320		1631		

DATE MAILED: 03/29/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/938,763	CAWSE, JAMES NORMAN	
	Examiner	Art Unit	
	Cheyne D Ly	1631	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on March 12, 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-7, 9, 10, 13-15, 17-36 and 39-42 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-7, 9, 10, 13-15, 17-36, and 39-42 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|------------------------------------------------------------------------------------------------------------------------|-----------------------------------------------------------------------------------------|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

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DETAILED ACTION

1. Applicants' arguments filed March 12, 2004 have been fully considered but they are not deemed to be persuasive. Rejections and/or objections not reiterated from previous office actions are hereby withdrawn. The following rejections and/or objections are either reiterated or newly applied. They constitute the complete set presently being applied to the instant application.
2. Applicant's request for reconsideration of the finality of the rejection of the last Office action is persuasive and, therefore, the finality of that action is withdrawn.
3. Claims 1-7, 9, 10, 13-15, 17-36, and 39-42 are examined on the merits.

CLAIM REJECTIONS - 35 U.S.C. § 112, SECOND PARAGRAPH

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5. Claims 1-7, 9, 10, 13-15, 17-36, and 39-42 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.
6. This rejection is maintained with respect to claims 1-7, 9, 10, 13-15, 17-36, and 39-42, as recited in the previous office action mailed February 24, 2004.
7. Specific to Applicant's pointed to support of paragraphs [0043], [0044], and the EXAMPLES to overcome the 35 U.S.C. 112, Second Paragraph rejection, the disclosure of "system has seven factors, each at two levels" (page 12, [0048]) further supports the vague and indefinite issue as discussed in the previous Office Action. The specification supports that a "system has seven factors", however, it is unclear how factors could comprise "a catalyst

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system." Further, claim 1 recites at least three factors interactions; it is unclear how "a catalyst system and conditions" are factor interactions or how "a catalyst system and conditions" represent at least three factor interactions. Lastly, the body of the claim is unclear as to how "a catalyst system and conditions" as factors are being used in accomplishing the intended of goal of the claimed method.

CLAIM REJECTIONS - 35 U.S.C. § 112, FIRST PARAGRAPH

8. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

9. Claims 1-7, 9,10, 13-15, 17-36, and 39-42 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. THIS IS A NEW MATTER REJECTION.

10. This rejection is maintained with respect to claims 1-7, 9,10, 13-15, 17-36, and 39-42, as recited in the previous office action mailed February 24, 2004.

11. Applicant's arguments that the term "greater or less than the standard deviation" is shown in the EXAMPLES, described in the specification with reference to "outside", and the phrase "greater or less" is found in 285 patents in the USPTO database have been fully considered and found to be unpersuasive as discussed below. The phrase "greater or less than the standard deviation" as related to the term "outside" has not been found in the specification as originally filed. Further, the appearance of the phrase "greater or less" in 285 patents in the USPTO

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database does not change the fact that said limitation lacks written description basis in the instant application as originally filed.

CLAIM REJECTIONS - 35 USC § 103

12. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

13. Claims 1-7, 9, 10, 13-15, 17-28, 34-36, and 39-42 are rejected under 35 U.S.C. 103(a) as being unpatentable over Agrafiotis et al. (US 5,901,069 A) taken with Grate et al. (US 6,408,250 B1).

14. This rejection is maintained with respect to claims 1-7, 9, 10, 13-15, 17-28, 34-36, and 39-42, as recited in the previous office action office action mailed February 24, 2004.

15. Claims 1-7, 9, 10, 13-36, and 39-42 are rejected under 35 U.S.C. 103(a) as being unpatentable over Agrafiotis et al. (US 5,901,069 A) taken with Grate et al. (US 6,408,250 B1) in view of Chaudhari et al. (US 5,917,077 A).

16. The rejection is maintained with respect to claims 1-7, 9, 10, 13-36, and 39-42, as recited in the previous office action office action mailed February 24, 2004.

RESPONSE TO ARGUMENTS

17. Specific to Applicant's argument of the references of Agrafiotis et al., Grate et al., and Chaudhari et al. as being of non analogous art, the same argument has been presented in

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Applicant's REMARKS, filed December 17, 2003. Applicant is directed to the FINAL OFFICE Action, mailed February 24, 2004, which has fully responded to said argument (Page 5, Paragraph 18).

18. Specific to Applicant's argument of the references of Agrafiotis et al., Grate et al., and Chaudhari et al. as being of improperly combined, the same argument has been presented in Applicant's REMARKS, filed December 17, 2003. Applicant is directed to the FINAL OFFICE Action, mailed February 24, 2004, which has fully responded to said argument (Page 6, Paragraphs 19-21).

19. Specific to Applicant's request that the PTO reissue the present Office Action to address the failure of the references to establish a prima facie case of obviousness of (1) defining an experimental space of a catalyzed chemical reaction to represent at least three factor interactions, "wherein the factors comprise a catalyst system and conditions". It is reiterated that Agrafiotis et al. discloses a system and method of defining an experimental space such as a combinatorial chemical library where a combinatorial chemical library could be constructed from chemical building blocks designated as A, B, and C (three factors). Further, the compounds in the combinatorial chemical library are equal to two in length, then, the compounds would be generated are: AA, AB,...and CC (total of nine) (column 5, lines 5-18 and column 6, lines 43-45).

20. Specific to the new limitation of "wherein the factors comprise a catalyst system and conditions", said new limitation, filed December 17, 2003, is vague and indefinite because it is unclear how factors could comprise "a catalyst system." The said new limitation has never been defined in the instant specification; therefore, the new limitation has been construed to be

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consistent with the disclosure of Agraftotis et al. as directed to the system and factors cited above, and rejected as being obvious over the prior in the FINAL OFFICE action, mailed February 24, 2004.

21. Specific to Applicant's argument directed to items (2) to (10), Applicant's arguments have been fully responded to in the previous Office Action, mailed February 24, 2003, (pages 7-8, paragraph 24).

22. Specific to Applicant's argument directed to claim 36, Applicant's arguments have been fully responded to in the previous Office Action, mailed February 24, 2003, (page 8, paragraph 25).

CONCLUSION

23. NO CLAIM IS ALLOWED.

24. Papers related to this application may be submitted to Technical Center 1600 by facsimile transmission. Papers should be faxed to Technical Center 1600 via the PTO Fax Center located in Crystal Mall 1. The faxing of such papers must conform with the notices published in the Official Gazette, 1096 OG 30 (November 15, 1988), 1156 OG 61 (November 16, 1993), and 1157 OG 94 (December 28, 1993) (see 37 CFR § 1.6(d)). The CM1 Fax Center number is (703) 872-9306.

25. Any inquiry concerning this communication or earlier communications from the examiner should be directed to C. Dune Ly, whose telephone number is (571) 272-0716. The examiner can normally be reached on Monday-Friday from 8 A.M. to 4 P.M.

26. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael Woodward, Ph.D., can be reached on (571) 272-0722.

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27. Any inquiry of a general nature or relating to the status of this application should be directed to Legal Instruments Examiner, Tina Plunkett, whose telephone number is (571) 272-0549.

C. Dune Ly
3/26/04

Ardin H. Marschel 3/26/04
ARDIN H. MARSCHEL
PRIMARY EXAMINER